

### REMARKS

The rejections presented in the final Office action mailed October 22, 2002 have been considered. Claims 1 and 3-46 are pending in this application. Reconsideration and allowance of the application, as amended, is respectfully requested.

In paragraph number 2, the Examiner has essentially maintained the same arguments as previously set forth by the Examiner. More particularly, Claims 1 and 3-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 93/23125 to Darling (hereinafter *Darling*) in view of U.S. Patent No. 5,999,808 to LaDue (hereinafter *LaDue*) and WO 98/47589 to Angell (hereinafter *Angell*). The Applicant respectfully traverses the Examiner's rejections. However, in order to facilitate prosecution of the application, independent Claims 1, 15, 28, and 42 have been amended.

Claim 1 has been amended to include that the mobile phones may be contacted via the communication during play of the game, via a call unrelated to the playing of the game. For example, the Specification sets forth that during a game, the mobile phones may be used for phone calls by interrupting the game, where the interactive game is interrupted only for the mobile phone receiving the call (p.11, lines 20-23). It is respectfully submitted that none of the references cited by the Examiner, *either alone or in combination*, teach a system where mobile phones are used to facilitate play of the game, where a dedicated game identification is used to identify the mobile phone for purposes of playing the game, but the mobile phone can still be contacted to carry out a call. In mobile networks, a network identification is used to contact a mobile device for purposes of communicating a voice or data call, and in accordance with the present invention, another identifier is used for each of the mobile phones where the identifier is dedicated for playing purposes.

As noted by the Examiner, *Darling* fails to disclose using a system on a plurality of mobile phones, and identification of each of the phones to be used for playing purposes and specific networks. The Examiner indicates that *LaDue* discloses the use of mobile phone technology to play games. However *LaDue* is not a multi-player system where communication is effected between the participants of a game, or between mobile

phones. Rather, *LaDue* describes a two way data communication video game caddy, where a player can place bets from a remote location within a casino, or anywhere that legal gambling is permitted (e.g., col. 2, lines 1-5). In other words, *LaDue* is a system for communicating gambling messages "two way" between a gaming terminal and a central monitoring station over a telecommunications network, but there is no interactive game played between users of the mobile devices. While a cellular communication system platform may be used in *LaDue*, it does not describe any manner in which different wireless device users participate in any activity with respect to one another.

*LaDue* does not indicate that mobile phones can be called during play of the its client/server-type gambling session, where such a call is unrelated to the gambling session. *Darling* does not teach such a feature either. *Angell*, like *LaDue*, teaches a wireless gambling system, where no multiplayer, interactive game is played *among the players*. It does not teach a multi-player system where communication is effected between participants of a game, or between mobile phones. Since none of *LaDue*, *Darling*, nor *Angell* teach such a feature, a combination of *LaDue*, *Darling*, and *Angell* fails to teach or suggest such a feature as well, and therefore the combination of references fails to teach all the elements of Claim 1. Independent Claims 15, 28, and 42 have been amended in a similar fashion. Because none of these references either alone or in combination teach or suggest at least this feature, a *prima facie* case of obviousness cannot be met, as a combination of such references fails to teach or suggest all of the elements of the claims and their limitations.

In making a 35 U.S.C. §103(a) rejection based on *Darling* in view of *LaDue* and *Angell*, there must be at least motivation to combine *Darling* with *LaDue*, and there must be at least motivation to combine *Darling* with *Angell*. With respect to motivation to combine *Darling* and *LaDue*, the Examiner asserted that the Examiner provided proper motivation to combine the *Darling* and *LaDue* references. The Examiner stated the following:

In this case, the motivation to combine has been highlighted above in bold type but will be repeated here for the convenience of the applicant's representative. The motivation of *Darling* pages 20-21 discloses that provided a standard communications protocol is employed, the present invention may be implemented to allow interactive game playing between

hand-held game machines manufactured by different companies and that in some circumstances other communications means may be advantageously employed and the motivation of LaDue that the wireless gaming system operates in normal cellular, paging, and signaling networks with the teachings of Angell that it is well known to have a player module associated with a player ID which could be a phone number.

The Applicant disagrees with the Examiner's characterization of the cited portion of *Darling*, and how it provides motivation to combine with the other cited references. What *Darling* is referring to when referring to a "standard communications protocol" is the flag, header, data, check, and end flag shown in *Darling*'s FIG. 5. In other words, *Darling* is saying that if all devices use the same protocol, then hand-held game machines manufactured by different companies can be used. The Examiner then identifies a "motivation of LaDue" as being that the wireless gaming system operates in normal cellular, paging, and signaling networks. The Applicant respectfully submits that the fact that using the same "protocol" in each of a plurality of hand-held game machines, and another system that operates in cellular, paging, and signaling networks, is not a motivation to combine such references. A "standard communication protocol" is used in a multitude of communication environments that do not employ cellular or other networks. Parallel and serial interfaces between two desktop computers (e.g., RS232, RS485, etc.), computers and printers, etc. use a "standard communication protocols," but have absolutely nothing to do with, nor do they imply, employing a cellular network to facilitate the communication therebetween.

The Applicant thus maintains the position that there is no motivation to combine the teachings of *Darling* and *LaDue*. There must be some actual *motivation* to combine these references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be

"clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.* As stated by the Federal Circuit:

"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

Where *Darling* does not involve devices capable of communication such as phone calls and rather involves a local network of "game machines," and *LaDue* does not involve multi-player, interactive games at all (rather, involves client-server, two way gambling), the Applicant submits that the only way to arrive at the present invention as claimed is through impermissible hindsight. It is respectfully submitted that portions of prior art documents were pieced together, using the presently-described invention as a blueprint, in an attempt to arrive at the invention as claimed.

With respect to *Angell*, this reference again refers to a wireless gambling system, where no multiplayer, interactive game is played *among the players*. It is a wireless application available to a wireless devices in a local area, and like *Darling* and *LaDue*, does not teach or suggest the capability of using mobile phones in their conventional fashion to receive calls during play of a game where mobile phone users collectively participate in the same game. Because neither *Darling*, *LaDue*, or *Angell*, either alone or in combination teach such a feature, the at least one prong of the requirements to establish a *prima facie* case of obviousness is not met: that all of the elements of the claim be taught or suggested.

As to the motivation to combine *Darling*, *LaDue*, and *Angell*, the Examiner has indicated that a player ID could be a phone number. It is submitted that this does not provide a motivation *to combine* such references. It is submitted that without the Applicant's disclosure, one skilled in the art would see the reference to the use of a phone number in the non-multiplayer environment of *Angell* as a motivation to combine an identification with the player-to-player game of the present invention.

Each of the dependent Claims are dependent from one of independent Claims 1, 15, 28, or 42, and each of the dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Darling*, *LaDue*, and *Angell*. While Applicant does not acquiesce with any particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent Claims 1, 15, 28, and 42. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, each of the pending dependent claims are also allowable over the combination of *Darling*, *LaDue*, and *Angell*.

#### CONCLUSION

Applicants respectfully submit that the pending claims are patentable over the cited prior art of record, and that the application is in condition for allowance. If the Examiner believes it necessary, the undersigned attorney of record may be contacted at the number below to discuss any issues related to this case.

Respectfully Submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120  
(651) 686-6633

By: 

Name: Steven R. Funk  
REG. NO.: 37,830

**APPENDIX A****AMENDED CLAIMS ILLUSTRATING CHANGES MADE THERETO  
PURSUANT TO 37 C.F.R. §1.121(c)(1)(ii)**

1. (Amended Four Times) A method for playing games between players at remote locations, comprising:

connecting a plurality of mobile phones to a communication network for playing a game, wherein each mobile phone is configured to engage in [provide telephone] communication through a mobile telecommunications system, and at least one of the plurality of mobile phones is connected to the communication network via a short range low power radio link;

providing an identification for each of the plurality of mobile phones, said identification being dedicated for playing purposes;

connecting the plurality of mobile phones together using said identifications dedicated for playing purposes;

setting up a game scenario for each of the plurality of mobile phones; [and]

transmitting game signals between the plurality of mobile phones across the communications network using the identifications for playing purposes, wherein the game signals are transmitted to the at least one of the plurality of mobile phones over the short range low power radio link[.]; and

wherein any of the plurality of mobile phones may be contacted, during playing of the game, via a call unrelated to the playing of the game by way of the communication network.

15. (Amended Four Times) A mobile phone, comprising:

a keypad for dialing, for controlling menu operation and for entering phone control functions;

a display for showing keypad entries and a game scenario; and

a controller for processing user input and for controlling the display, the controller providing identification for playing purposes and using a first transceiver configured to make mobile telecommunications connections and using a second transceiver to connect

the mobile phone to at least one other mobile phone through a communication network using said identifications for playing purposes for playing an interactive game and transmitting game signals to the communication network for reception by the at least one other mobile phone using a short range low power radio connection, wherein the mobile phone is configured to receive mobile telecommunications calls unrelated to the playing of the interactive game during playing of the interactive game.

28. (Amended Four Times) An interactive game system, comprising:  
a communication network; and  
a plurality of mobile phones coupled together through the communication network, at least one of the mobile phones comprising a controller for processing user input and for controlling a display, the controller providing identification for playing purposes and using a first transceiver configured to make mobile telecommunications connections and using a second transceiver to connect the mobile phone to at least one other mobile phone through a communications network using said identifications for playing purposes for playing an interactive game and transmitting game signals to the communication network for reception by the at least one other mobile phone using a short range low power radio connection, wherein at least some of the mobile phone are configured to receive mobile telecommunications calls unrelated to the playing of the interactive game during playing of the interactive game.

42. (Once Amended) A method for playing interactive games, comprising:  
providing a plurality of communication systems for coupling mobile phones together, each mobile phone being configured to provide telephone communications;  
coupling, through one or more of the plurality of communication systems, the mobile phones together for playing a game;  
setting up an interactive game scenario for each mobile phone; [and]  
transmitting game signals between the mobile phones through the one or more communication systems coupling the mobile phones[.]; and

wherein any of the mobile phones may be contacted, during participation of the interactive game, via a call unrelated to the interactive game by way of at least one of the plurality of communication systems.